

The Honorable Richard A. Jones

UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

INTELLECTUAL VENTURES I LLC
AND INTELLECTUAL VENTURES II
LLC,

Plaintiffs,

v.

HYNIX SEMICONDUCTOR INC.;
HYNIX SEMICONDUCTOR AMERICA
INC.; ELPIDA MEMORY, INC.; ELPIDA
MEMORY (USA) INC.; ACER, INC.;
ACER AMERICA CORP.; ADATA
TECHNOLOGY CO., LTD.; ADATA
TECHNOLOGY (U.S.A.) CO., LTD.
ASUSTEK COMPUTER INC.; ASUS
COMPUTER INTERNATIONAL INC.;
DELL, INC.; HEWLETT-PACKARD
COMPANY; KINGSTON
TECHNOLOGY CO., INC.; LOGITECH
INTERNATIONAL S.A.; LOGITECH,
INC.; PANTECH CO., LTD.; PANTECH
WIRELESS, INC.; BEST BUY CO., INC.;
WAL-MART STORES, INC., NANYA
TECHNOLOGY; NANYA
TECHNOLOGY CORPORATION, USA

Defendants.

Case No. 2:11-cv-01145-RAJ

MOTION TO STAY DISTRICT COURT
ACTION PENDING FINAL
RESOLUTION OF ITC
INVESTIGATION FOR
DEFENDANTS:

- HYNIX SEMICONDUCTOR, INC.;
- HYNIX SEMICONDUCTOR
AMERICA INC.;
- ELPIDA MEMORY, INC.;
- ELPIDA MEMORY (USA) INC.;
- ACER, INC.;
- ACER AMERICA CORP.;
- ADATA TECHNOLOGY CO., LTD.;
- ADATA TECHNOLOGY (U.S.A.)
CO., LTD.;
- ASUSTEK COMPUTER, INC.;
- ASUS COMPUTER
INTERNATIONAL, INC.;
- BEST BUY CO., INC.;
- DELL, INC.;
- HEWLETT-PACKARD COMPANY;
- KINGSTON TECHNOLOGY CO.,
INC.;
- LOGITECH INTERNATIONAL
S.A.; and
- LOGITECH, INC.

**NOTE ON MOTION CALENDAR:
OCTOBER 7, 2011**

MOTION TO STAY DISTRICT COURT
ACTION PENDING ITC INVESTIGATION - 1
Case No. 2:11-cv-01145-RAJ

K&L GATES LLP
925 FOURTH AVENUE
SUITE 2900
SEATTLE, WASHINGTON 98104-1158
TELEPHONE: (206) 623-7580
FACSIMILE: (206) 623-7022

Defendants Hynix Semiconductor, Inc., Hynix Semiconductor America, Inc., Elpida Memory, Inc., Elpida Memory (USA) Inc., Acer Inc., Acer America, Corp., ADATA Technology Co., Ltd., ADATA Technology (U.S.A.) Co., Ltd., Asustek Computer Inc., Asustek Computer International Inc., Best Buy Co., Inc., Dell, Inc., Hewlett-Packard Company, Kingston Technology Co., Inc., Logitech International S.A., and Logitech Inc. (collectively “Defendants”) submit this motion for an order staying Plaintiffs Intellectual Ventures I LLC’s (“Intellectual Ventures I”) and Intellectual Ventures II LLC’s (“Intellectual Ventures II”) (collectively, “Intellectual Ventures I and II”) above-entitled action under 28 U.S.C. § 1659(a), until such time as there is a final, unappealable decision in a parallel proceeding Intellectual Ventures I and II filed against Defendants with the U.S. International Trade Commission (“ITC”) entitled *In the Matter of Certain Dynamic Random Access Memory and NAND Flash Memory Devices and Products Containing Same*, Investigation No. 337-TA-803 (“803 ITC Investigation”). Defendants’ motion is based on the following facts:

1. On July 11, 2011, Intellectual Ventures I and II filed a complaint in the United States District Court for the Western District of Washington (“Washington Complaint”), Civil Action No. 2:11-cv-01145-RAJ, entitled *Intellectual Ventures I LLC and Intellectual Ventures II LLC v. Hynix Semiconductor America, Inc. et al.* In their Complaint, Intellectual Ventures I and II alleges that Defendants infringed United States Patent No. 5,654,932, United States Patent No. 5,963,481, United States Patent No. 5,982,696, United States Patent No. 5,500,819, and United States Patent No. 5,687,132. (*See* Dkt. #1).

2. On July 12, 2011, Intellectual Ventures I and II, along with Complainants Intellectual Ventures Management, LLC, Invention Investment Fund I, LLC, and Invention Investment Fund II, LLC (collectively “IV”), also filed a complaint against Defendants under section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. §1337, with the ITC. (*See*, Declaration of Theo Angelis, Ex. A). In IV’s ITC investigation, it alleges violations of

1 section 1337 based on Defendants' asserted infringement of United States Patent No.
2 5,654,932, United States Patent No. 5,963,481, United States Patent No. 5,982,696, United
3 States Patent No. 5,500,819, and United States Patent No. 5,687,132—the same patents at
4 issue in its present civil action.

5 3. On August 31, 2011, the International Trade Commission issued a Notice of
6 Institution of Investigation based on IV's ITC Complaint and ordered an investigation entitled
7 *In the Matter of Certain Dynamic Random Access Memory and NAND Flash Memory Devices*
8 *and Products Containing Same*, Investigation No. 337-TA-803 (*Id.* at Ex. B, Notice of
9 Investigation).

10 4. Upon the request of any party to a civil action who is also a respondent in an
11 ITC investigation involving the parties in the civil action, the Court "shall stay, until the
12 determination of the Commission becomes final, proceedings in the civil action with respect
13 to any claim that involves the same issues involved in the proceeding before the
14 Commission." 28 U.S.C. § 1659(a). This stay is mandatory and must be granted if it is made
15 within thirty days from the later of: (1) the party being named a respondent in a proceeding
16 before the ITC, or (2) the filing of the district court action. 28 U.S.C. § 1659(a)(1)-(2); *see*
17 *also In re Princo*, 478 F. 3d 1345, 1355 (Fed. Cir. 2007) (granting a writ of mandamus and
18 directing a district court to stay proceedings pursuant to 28 U.S.C. § 1659(a) until the ITC
19 proceeding becomes final).

20 5. Defendants are respondents in the 803 ITC Investigation and also are named
21 defendants in this action. Intellectual Ventures I and II alleges infringement of United States
22 Patent No. 5,654,932, United States Patent No. 5,963,481, United States Patent No.
23 5,982,696, United States Patent No. 5,500,819, and United States Patent No. 5,687,132 in
24 both the 803 ITC Investigation and this parallel civil action. Accordingly, the two
25 proceedings involve the same issues within the meaning of 28 U.S.C. § 1659(a).

1 6. On September 7, 2011, the 803 ITC Investigation was instituted upon
2 publication of the Notice of Investigation in the *Federal Register*. Thus, Defendants have
3 filed their request to stay Intellectual Ventures I and II's present action within thirty days of
4 being named as respondents in the 803 ITC Investigation.

5 7. In view of Intellectual Ventures I and II's co-pending action against
6 Defendants involving United States Patent No. 5,654,932, United States Patent No.
7 5,963,481, United States Patent No. 5,982,696, United States Patent No. 5,500,819, and
8 United States Patent No. 5,687,132 currently before the ITC, Defendants hereby move to stay
9 the above-entitled action under 28 U.S.C. § 1659(a) until such time as there is a final,
10 unappealable decision in the 803 ITC Investigation.

11 8. Defendants make this motion without waiving any procedural rights, or
12 defenses that may be raised by motion or otherwise under the Federal Rules of Civil
13 Procedure or the Local Rules of this Court.

14 DATED this 21st day of September, 2011.

15 K&L GATES LLP

16 By s/ Theodore J. Angelis

17 Theodore J. Angelis, WSBA # 30300
18 925 Fourth Avenue, Suite 2900
19 Seattle, WA 98104
20 Phone: (206) 623-7580
21 E-mail: theo.angelis@klgates.com

22 Karineh Khachatourian
23 630 Hansen Way
24 Palo Alto, CA 94304
25 Tel: (650) 798-6725
 Fax: (650) 798-6701
 Email: karineh.khachatourian@klgates.com

 Attorneys for Defendants
 Hynix Semiconductor, Inc.,
 Hynix Semiconductor America Inc.,
 Acer, Inc.,
 Acer America Corp.,
 ADATA Technology Co., Ltd.,

1 ADATA Technology (U.S.A.) Co., Ltd.,
2 Asustek Computer, Inc.,
3 Asus Computer International, Inc.,
4 Best Buy Co., Inc.
5 Dell, Inc.,
6 Hewlett-Packard Company,
7 Kingston Technology Co., Inc.,
8 Logitech International S.A.,
9 Logitech, Inc.

HILLIS CLARK MARTIN & PETERSON P.S.

By s/ Laurie Lootens Chyz (by email consent)

Louis D. Peterson, WSBA #5776
Laurie Lootens Chyz, WSBA #14297
Alexander M. Wu, WSBA #40649
1221 Second Avenue, Suite 500
Seattle WA 98101-2925
Tel: (206) 623-1745
Fax: (206) 623-7789
Email: ldp@hcmp.com;
llc@hcmp.com;
amw@hcmp.com

KENYON & KENYON LLP
George E. Badenoch
Thomas R. Makin
Rose Cordero Prey
Christopher M. Scott
One Broadway
New York, NY 10004-1007
Telephone: (212) 425-7200
Facsimile: (212) 425-5288
Email: gbadenoch@kenyon.com;
tmakin@kenyon.com;
rcordero@kenyon.com;
cscott@kenyon.com

Attorneys for Defendants
Elpida Memory, Inc. and
Elpida Memory (USA) Inc.

CERTIFICATE OF ECF FILING AND SERVICE

I certify that on September 21, 2011, I arranged for electronic filing of the foregoing document with the Clerk of the Court using the CM/ECF system, which will send notification of such filing to all parties of record.

s/ Theodore J. Angelis

Theodore J. Angelis

K&L Gates LLP

925 Fourth Avenue, Suite 2900

Seattle, WA 98104

Phone: (206) 623-7580

Fax: (206) 623-7022

E-mail: theo.angelis@klgates.com